

REMARKS

Applicant has carefully reviewed the Office Action mailed December 9, 2008, and thanks Examiner Diaz for the detailed review of the pending claims. In response to the Office Action, Applicant has amended claims 1, 8, 27, and 29-30. Claims 2, 5-6, 26 and 28 were previously cancelled. By way of this amendment, no new matter has been added. Accordingly, claims 1, 3, 4, 7-25, 27, and 29-30 remain pending in this application. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections.

Claims 29 and 30 were rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the enablement requirement. Claims 1, 3, 4, and 7-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 1, 7, 17, 18, and 21-24 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/501,821. Claims 1, 4, 7, 15, 21, 26 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by Willford et al. (US Patent 5,566,579). Claims 1, and 7-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Meyers et al. (U.S. Patent 4,892,001). Claims 1, and 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Okubo et al. (U.S. Patent 4,608,877). Claims 1, 27, 29, and 30 were rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (U.S. Patent No. 4,580,457). Applicants note that the Ishida reference was not cited in the non-final Office Action dated May 23, 2008.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR

1.104(d)(2) and MPEP § 2144.03. Applicant respectfully requests reconsideration of the present application in view of the above amendment, and the following remarks.

Objection to the Drawings

Applicant notes that the Office Action Summary Sheet is marked as having objections to the drawings. However, the Detailed Action makes no mention to the drawing objections. Therefore, it is believed that no modifications are required. Applicant respectfully requests more detail from the Examiner if any drawing changes are required.

Claim Rejections – 35 USC §112

Claims 29 and 30 were rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the enablement requirement for allegedly containing subject matter which was not described in the specification in such a way as to enable one of skill in the art which it pertains to make and use the invention. Specifically, the Examiner alleged that claims 29 and 30 both recite, in part “wherein neither the traversing member nor the carrier member rotate to move the shift finger,” however, neither the traversing member nor the carrier member rotate to move the shift finger (*Office Action, page 4*). In particular, the Examiner alleged that it was unclear how Applicant’s device can perform the recited function as the shift finger is actually responsible for moving the traversing member and the carrier member (*Office Action, Page 4*). Accordingly, claims 29-30 have been amended to recite “the shift element” instead of “the shift finger,” as the Examiner suggested.

Claims 1, 3, 4, and 7-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner alleged that claim 1 recites “a coupling” twice. Accordingly, has amended claim 1 to recite “a coupling” only once. The Examiner also alleged that claim 8 recites “the direction,” but it is unclear which direction the Applicant is referring to. Applicant has amended claim 8 to recite “the second orthogonal direction.” Reconsideration and withdrawal of these rejections are respectfully requested.

Double Patenting

Claims 1, 7, 17, 18, and 21-24 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/501,821 (the '821 application). Since the rejection is only provisional Applicant will respond on the merits, if necessary, in due course.

Claim Rejections – 35 USC § 102

1. The Law

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

2. Willford et al. (US Patent 5,566,579)

Claims 1, 4, 7, 15, 21, 26 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by Willford et al. (US Patent 5,566,579). Applicant respectfully traverses the rejection.

a. Independent Claim 1

Amended independent claim 1 recites in part that “the bearing means comprises a traversing member located in the cassette housing and movable in a first orthogonal direction for selecting a shift rail,” and “a carrier member supported by the traversing member and moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails,” (emphasis added).

Support for these amendments can be found in at least page 12, lines 3-21 and page 4, lines 14-16 of the international application, as well as FIGs. 7-8.

Willford does not teach all of the recitations found in claim 1. Therefore, Willford cannot anticipate independent claim 1. In particular, the Examiner asserts that the automatic shift member 32 of Willford corresponds to the “carrier member” of claim 1, the mode selecting pistons 50 and 51 correspond with the “traversing member,” and that Willford teaches that the member 32 rotates in a second orthogonal direction for “axially moving a selected one of the shift rails,” (*Office Action, Page 7*). However, a close reading of Willford reveals that Willford actually teaches that “rotational movement of the automatic shift member 32 and the automatic shaft 31 . . . will cause axial movement of the shift rail 22,” (emphasis added) (*column 8, lines 62-66*). More specifically, as best seen in FIG. 2 (reproduced below) Willford teaches that “the automatic shift member 32 is supported on the automatic shift shaft 31 for axial movement relative thereto. . . but is restrained by the key 34 for rotational movement therewith,” (*column 7, lines 36-40*).

Therefore, Willford only teaches that the shift member 32 moves axially in a direction that is parallel with the shift shaft 31 and the pistons 50 and 51, and that the shift member 32 rotates in a direction that is perpendicular to the shift shaft 31 and the pistons 50 and 51. In contrast, claim 1 recites “a carrier member” that is “moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails.” Accordingly, Willford does not teach every recitation of independent claim 1, as required by *Verdegaal Bros.*

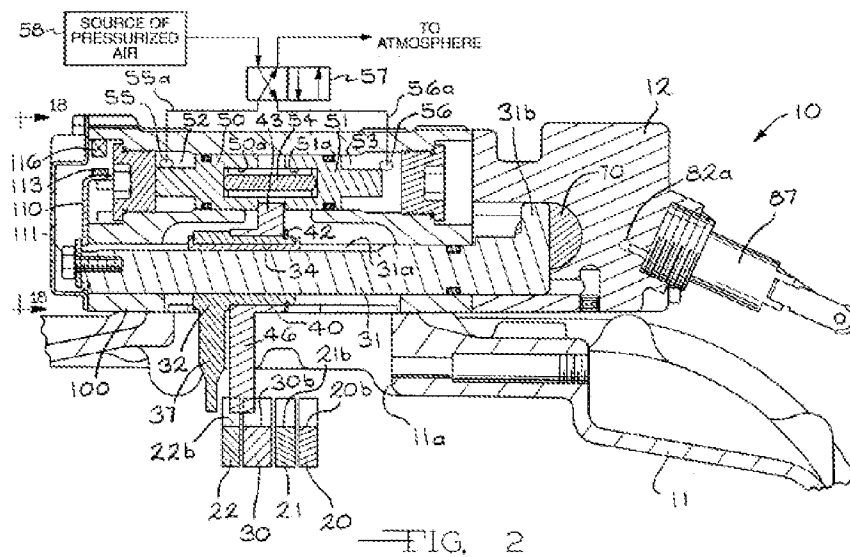


FIG. 2 of Willford

Dependent claims 2, 4, 7, 15, 21, 26 depend from patentable independent claim 1 and include additional recitations that are separately patentable. Merely by way of example, claim 21 recites “wherein two shift elements having the shape of tongues are provided which extend into shift rail connecting members and being spaced apart in the first orthogonal direction.” Willford does not teach these features. Accordingly, withdrawal of the rejection is respectfully requested.

b. Independent Claim 27

As with independent claim 1, Willford does not teach numerous, if any, of the recitations of claim 27, which recites, in part “axially moving a selected one of the shift rails in a linear direction,” “the axial direction generally perpendicular to the first orthogonal direction,” and where “the carrier member being supported by the traversing member and movable in the axial direction.” As argued above with respect to claim 1, Willford does not teach or suggest “a carrier member supported by the traversing member and moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails.” Accordingly, Willford cannot teach or suggest any of the other recitations of claim 27, which also recites “axially moving a selected one of the shift rails in a linear direction.” For at least the foregoing reasons, the rejection of claim 27 should be withdrawn.

3. Meyers et al. (U.S. Patent 4,892,001)

Claims 1 and 7-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Meyers et al. (U.S. Patent 4,892,001). Applicant respectfully traverses the rejection.

Amended independent claim 1 recites in part that “the bearing means comprises a traversing member located in the cassette housing and movable in a first orthogonal direction for selecting a shift rail,” and “a carrier member supported by the traversing member and moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails,” (emphasis added). Support for these amendments can be found in at least page 12, lines 3-21 and page 4, lines 14-16 of the international application, as well as FIGs. 7-8.

Meyers does not teach all of the recitations found in claim 1. Therefore, Meyers cannot anticipate independent claim 1. In particular, the Examiner asserts that the “ball portion of 13 and lower part beneath the ball” of Meyers corresponds to the “carrier member” of claim 1, and that the ball “is moveable in the second orthogonal direction for axially moving a selected one of the shift rails,” (*Office Action, Page 12*). However, Meyers actually teaches that “the aperture 21 and the pin 22 permit the shift lever 13 to pivot about the axis defined by the pivot pin 22 . . . as shown in the curved arrow 23,” (emphasis added) (*column 3, lines 44-47 and FIG. 2*). As seen in FIG. 2 (reproduced below for the Examiner’s convenience) Meyers teaches that the shift lever rotates about the pin 22 where “the tang portion 37 of the shift lever 13 moves out of the notch 27a formed in the center shift bar 27” and into one of the other shift rails (*column 4, lines 43-45*). In contrast, claim 1 recites “a carrier member” that is “moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails.” In other words, Meyers does not teach that the shift lever 13 moves in a “linear second orthogonal direction,” but rather “rotates about the pin 22,” which is denoted by the curved arrow 23 in FIG. 2. Accordingly, Meyers does not teach every recitation of independent claim 1, as required by *Verdegaal Bros.*

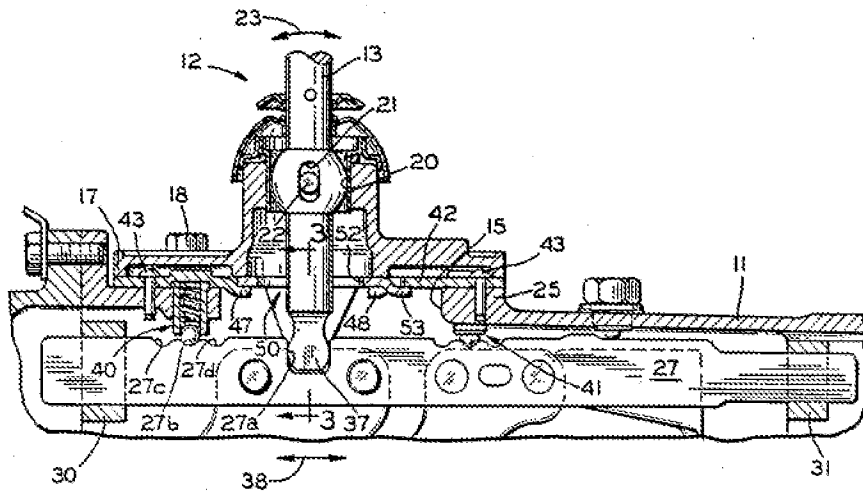


FIG. 2 of Meyers

Dependent claims 7-20 depend from patentable independent claim 1 and include additional recitations that are separately patentable. Merely by way of example, claim 8 recites “wherein the traversing member comprises an oblong opening with the carrier member located therein and movable in the second orthogonal direction.” Meyers does not teach these features. Accordingly, withdrawal of the rejection is respectfully requested.

4. **Okubo et al. (U.S. Patent 4,608,877)**

Claims 1, and 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Okubo et al. (U.S. Patent 4,608,877). Applicant respectfully traverses the rejection.

Amended independent claim 1 recites in part that “the bearing means comprises a traversing member located in the cassette housing and movable in a first orthogonal direction for selecting a shift rail,” and “a carrier member supported by the traversing member and moveable in a linear second orthogonal direction for axially moving a selected one of the shift rails,” (emphasis added). Support for these amendments can be found in at least page 12, lines 3-21 and page 4, lines 14-16 of the international application, as well as FIGs. 7-8.

Okubo does not teach all of the recitations found in claim 1. Therefore, Okubo cannot anticipate independent claim 1. In particular, the Examiner asserts that the gear shift shaft 7 of

Okubo corresponds to the “traversing member” and the fingers 12 and 13 correspond to the “carrier member” of claim 1 (*Office Action, Page 16*). However, Okubo teaches that “the gear shift shaft can be moved linearly in the axial direction and pivotably about its axis,” (*column 2, lines 19-21*), and that the fingers 12 and 13 are held in place with the two U-shaped members 14 and 14’ (*column 3, lines 7-8*). As seen in FIG. 1 (reproduced below for the Examiner’s convenience) Okubo teaches that when “the gear shift shaft 7 is moved axially, the U shaped members are moved therewith,” and “when the gear shift shaft is turned, the turning of the U-shaped members is prevented,” (*column 3, lines 13-17*). Therefore, according to Okubo the fingers 12 and 13, which the Examiner asserts correspond with the “carrier member,” actually **teach away** from movement in the “second orthogonal direction” because the fingers 12 and 13 are prevented from turning. In other words, Okubo only teaches that the fingers 12 and 13 move with the gear shift shaft 7 in a parallel direction, and not a “second orthogonal direction.” In contrast, claim 1 recites “a traversing member” that is “movable in a first orthogonal direction for selecting a shift rail,” and “a carrier member supported by the traversing member and moveable in a linear second orthogonal direction.” Accordingly, Okubo does not teach every recitation of independent claim 1, as required by *Verdegaal Bros.*

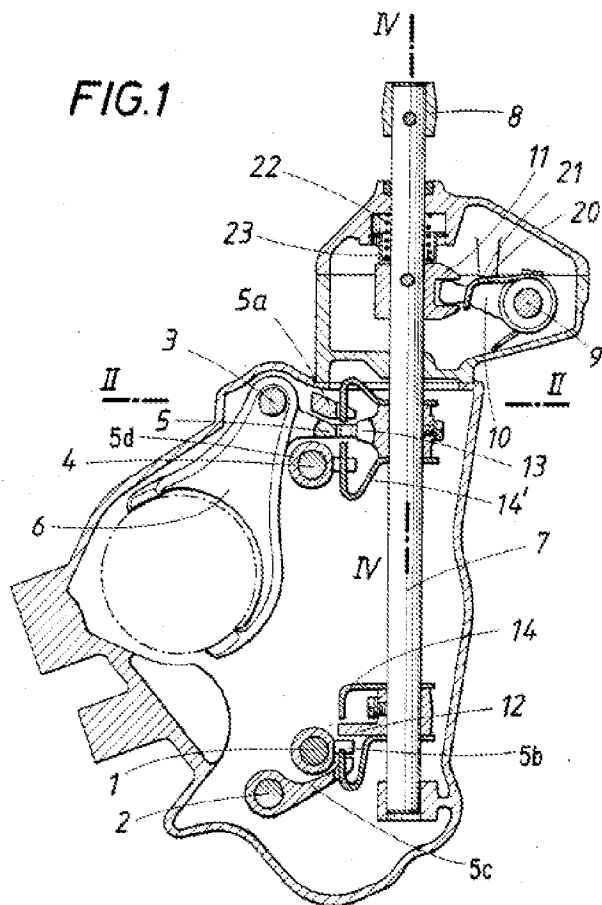


FIG. 1 of Okubo

Dependent claims 21-24 depend from patentable independent claim 1 and include additional recitations that are separately patentable. Merely by way of example, claim 21 recites “wherein two shift elements having the shape of tongues are provided which extend into shift rail connecting members and being spaced apart in the first orthogonal direction.” Okubo does not teach these features. Accordingly, withdrawal of the rejection is respectfully requested.

5. Ishida et al. (U.S. Patent No. 4,580,457)

Claims 1, 27, 29, and 30 were rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (U.S. Patent No. 4,580,457). Applicant respectfully traverses the rejection.

a. Independent Claim 1

Amended independent claim 1 recites in part that “the at least one shift element is moveable in one of the first orthogonal direction and the second orthogonal direction,” (emphasis added). Support for these amendments can be found in at least page 12, lines 3-21 and page 4, lines 14-16 of the international application, as well as FIGs. 7-8.

Ishida does not teach all of the recitations found in claim 1. Therefore, Ishida cannot anticipate independent claim 1. Ishida teaches that “the shift actuator 3 pivot[s] the internal lever 4 into a predetermined shift position,” (*column 4, lines 37-39*), where the piston rod 331 of the shift actuator moves to the left or to the right to actuate one of the shift rods 6a, 6b or 6c (*column 3, lines 36-50*). Indeed, as seen in FIG. 2 (reproduced below for the Examiner’s convenience) Ishida teaches that the internal lever 4 engages with one of the shift block 6b by pivoting about a rod 52, to the left or right of the piston rod 331. In contrast, claim 1 recites that “the at least one shift element is moveable in both of the first orthogonal direction and the second orthogonal direction.” Ishida does not teach that the internal lever 4 moves in a “first orthogonal direction” and “second linear orthogonal direction,” but rather “pivots” in one direction to the left or right of the piston rod 331. Accordingly, Ishida does not teach every recitation of independent claim 1, as required by *Verdegaal Bros.*

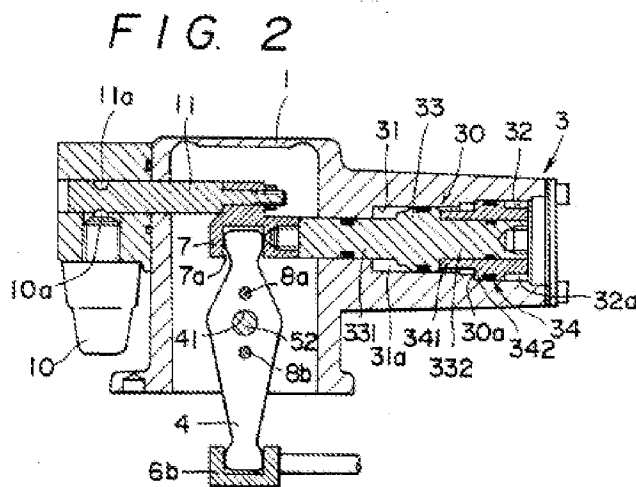


FIG. 2 of Ishida

Dependent claim 29 depends from patentable independent claim 1 and is patentable at least by being dependent on allowable base claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

b. Independent Claim 27

As with independent claim 1, Ishida does not teach numerous, if any, of the recitations of claim 27, which recites, in part “a shift element is moved in the axial direction and the first orthogonal direction to selectively engage the connecting members of the shift rails,” where “the axial direction generally perpendicular to the first orthogonal direction.” As argued above with respect to claim 1, Ishida does not teach or suggest “a first orthogonal direction” or a “second linear orthogonal direction.” Accordingly, Ishida cannot teach or suggest any of the other recitations of claim 27, which also recites “a shift element is moved in the axial direction and the first orthogonal direction.” For at least the foregoing reasons, the rejection of claim 27 should be withdrawn.

Dependent claim 30 depends from patentable independent claim 27 and is patentable at least by being dependent on allowable base claim 27. Accordingly, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65856-0062 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: February 9, 2009

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